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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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wellington

Mailed: November 28, 2005

Opposition No. 91154595

Bruker Daltonics, Inc.

v.

PerSeptive Biosystems, Inc.
and
Applied Biosystems/MDS Sciex
Instruments (joined as party
defendant)¹

Before Seeherman, Hohein and Hairston,
Administrative Trademark Judges.

By the Board:

On July 10, 2001, PerSeptive Biosystems, Inc. filed application Serial No. 78073160 to register the mark TOF/TOF for "mass spectrometry instrumentation, namely time-of-flight mass spectrometers and components therefor, and related software, for use in chemical and biological applications" in International Class 9. The application, which has subsequently been assigned to and is presently

¹ On November 9, 2004, the entire interest in the subject application was assigned from PerSeptive Biosystems, Inc. to Applied Biosystems/MDS Sciex Instruments (recorded with the Assignment Division at Reel 2972, Frame 0163). Accordingly, the Board *sua sponte* joins Applied Biosystems/MDS Sciex Instruments as the applicant and party in the position of defendant. See TBMP Section 512.01 and *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1910 n.1 (TTAB 2000)(assignee joined at final decision).

owned by Applied Biosystems/MDS Sciex Instruments, is based on an allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act.

During the prosecution of the application, the examining attorney issued a final office action refusing registration to applicant based on Section 2(e)(1) of the Trademark Act, namely, that the mark was merely descriptive of the goods. In response to this office action, applicant filed a request for reconsideration wherein it argued that its mark was not descriptive but merely suggestive. In the alternative, applicant argued that its mark should be allowed to register under Section 2(f) of the Trademark Act because the proposed mark had acquired distinctiveness. Applicant based its Section 2(f) acquired distinctiveness claim on its ownership of Registration No. 2593108 for the mark MALDI TOF/TOF for an "ion source for mass spectrometer" in International Class 9.²

The examining attorney considered applicant's alternative Section 2(f) argument; accepted applicant's ownership of the prior registration as a prima facie showing of acquired distinctiveness for the TOF/TOF mark; and approved the application for publication of such mark for

² The registration issued on July 9, 2002. The Board notes that the registration is not over five years old.

opposition. Accordingly, on November 12, 2002, the mark was published for opposition in the Trademark Official Gazette.

On January 10, 2003, opposer, Bruker Daltonics, Inc., filed a notice of opposition opposing registration of applicant's mark on the grounds that the mark is generic for the identified goods and, in the alternative, that the mark is merely descriptive of the identified goods.

Specifically, opposer alleges, *inter alia*, that "since 1980, [opposer] has been involved in the manufacture and sale of analytical instruments, some of which are similar to applicant's goods, and which opposer has a valid and legal right to describe by using the term sought to be registered by the applicant"; that "applicant's alleged mark is integral to the accurate and efficient description of some of opposer's products, and if a registration is granted to the applicant, it will impair Opposer's right to use the term 'TOF/TOF'"; that "the alleged mark functions as the common descriptive name of the goods enumerated in the above-referenced application, and has become the generic name for all such goods produced and sold by every competitor engaged in such business"; and that, alternatively, "the mark, when used in connection with the goods enumerated in the above-referenced application, is merely descriptive."

On March 6, 2003, applicant filed its answer denying the salient allegations of the notice of opposition.

On August 13, 2004, opposer filed a motion for summary judgment on the grounds that applicant's mark is either generic or merely descriptive of the goods identified in the application.

Even though the parties briefed the summary judgment motion, in our order dated February 10, 2005, we explained that we were deferring consideration of opposer's summary judgment motion because the parties' briefs did not contain arguments concerning an essential issue in this proceeding and allowed the parties additional time to file supplemental briefs on the issue.³ Specifically, the parties' original briefs on the motion had no discussion of the issue of whether applicant's proposed mark had acquired distinctiveness. In the February 10, 2005 order, we pointed out that the application at issue was published for opposition under Section 2(f) of the Trademark Act based on applicant's declaration (in the prosecution of its application) that its mark had acquired distinctiveness based on its prior registration as proof of the acquired distinctiveness. In its brief in opposition to the summary

³ We also advised the parties that, for purposes of the summary judgment record, we were considering all previous arguments and submissions and that the order was not to be construed as containing any decision on the merits of the parties' allegations in the motions.

judgment motion, applicant referenced its ownership of the prior registration and argued, in the alternative, that it "believes that the mark TOF/TOF is distinctive of the goods as evidenced by [its ownership of the prior] registration on the Principal Register for the same mark for related goods." Applicant did not specifically argue that its mark had acquired distinctiveness.

The parties have now filed their supplemental briefs on the issue of whether applicant's mark has acquired distinctiveness.⁴

Issues Before the Board

The summary judgment motion now having been fully briefed, the Board is faced with the following issues: (1) whether the mark is merely descriptive and/or generic; and (2) assuming the mark is determined to be merely descriptive but not generic, whether acquired distinctiveness has been established so as to be registrable. *In re Harrington*, 219 USPQ 854, 855 n.1 (TTAB

⁴ On April 4, 2005, applicant filed a motion for an extension of time (up to April 25, 2005) to file its supplemental brief with opposer's alleged consent. On April 8, 2005, opposer filed a communication stating that it did not consent to applicant's extension request but merely stated that it would not oppose said request. On July 1, 2005, applicant filed a motion for leave to accept a late filed copy of its supplemental brief wherein it states that it served opposer with a copy of its supplemental brief on April 25, 2005, but that it "inadvertently missed" filing a copy thereof with the Board. Opposer did not oppose the latter motion. Accordingly, applicant's motions are granted as conceded and its supplemental brief is accepted and considered. Trademark Rule 2.127(a).

1983). In other words, if we find that the mark is not generic but that it is merely descriptive, we then must determine whether the evidence supports a finding that the mark has acquired distinctiveness and thus is registrable pursuant to Section 2(f). *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 918 (TTAB 1983). Thus, the Board considers the issues before us in this case to be genericness, descriptiveness, and whether applicant's mark has acquired distinctiveness. Moreover, since this is a motion for summary judgment our determination of these issues must be in the context of whether there are any genuine issues of material fact.

Parties' Arguments and Submissions

In support of its motion for summary judgment, opposer argues that applicant's mark TOF/TOF is "merely a long-standing abbreviation for a tandem (i.e., back-to-back) time-of-flight mass spectrometer"; that applicant's identified goods "include time-of-flight mass spectrometers, which for nearly sixty years have been conventionally referred to as "TOF" mass spectrometers"; that "[w]hen tandem time-of-flight mass spectrometers were developed almost twenty years ago, the abbreviation "TOF/TOF" was readily adopted in the industry to refer to and describe such instruments and their function (i.e., to perform time-of-flight analyses in tandem)"; that "to the relevant

consumer and user of mass spectrometers, the term 'TOF/TOF' readily conveys information about the nature of the goods, namely that they perform tandem time-of-flight mass spectrometry"; that "the genus of goods for which registration is sought is therefore tandem time-of-flight mass spectrometry instrumentation" and "numerous patents, trade journals, and other publicly available materials unquestionably show that "TOF/TOF" is understood by the relevant public to exclusively refer to tandem time-of-flight mass spectrometers"; and that the evidence of record "indisputably shows that the term 'TOF/TOF' is, at the least, merely descriptive" and "...actually goes further, and shows that the mark is generic when used on applicant's goods."

Opposer also submitted a declaration of Michael J. Zinna, Esq., counsel for opposer, with the following exhibits: a 1994 publication from the American Chemical Society titled "Time-of-Flight Mass Spectrometry" containing articles involving tandem mass spectrometry; photocopies of two patents (Patent Nos. 4,851,669 and 5,206,508) involving tandem mass spectrometers; a copy of a curriculum vitae for Catherine C. Fenselau; a copy of an article by Ms. Fenselau titled "MALDI MS and Strategies for Protein Analysis," published in Analytical Chemistry News & Features, November 1, 1997; copies of abstracts published in conjunction with

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ASMS (American Society for Mass Spectrometry) Conferences on Spectrometry and Allied Topics for the years 1999 and 2001; a copy of a progress report for the period December 1991-November 1994 entitled "Development of Laser-ion Beam Photodissociation Methods" by D.H. Russell, Department of Chemistry, Texas A&M University; a copy of a patent cooperation treaty application (No. 9901889, dated January 14, 1999) entitled "novel mass spectrometer"; copies of several articles involving mass spectrometry; copies of dictionary definitions of the terms "time-of-flight" and "TOF" from an online Merriam-Webster Medical Dictionary (2003); and a copy of applicant's responses to opposer's requests for admission.

In opposition to opposer's summary judgment motion, applicant argues that its mark is "neither descriptive nor generic," but "is rather highly suggestive of the applicant's goods"; that it "is not true that the entire mass spec industry uses the [term] 'TOF/TOF' to describe time-[of flight] tandem, rather the industry would use 'Time-of-Flight MS/MS' to describe the technology"; that, in the alternative, the mark "TOF/TOF" is "distinctive of the associated goods as evidenced by Applicant's ownership of Registration No. 2593108 for the mark MALDI TOF/TOF"; and that because the USPTO issued Registration No. 2593108 for the mark MALDI TOF/TOF, without any disclaimer, the term

"TOF/TOF" is "distinctive and registrable." In its supplemental brief on the issue of acquired distinctiveness, applicant asserts that it first used the mark TOF/TOF in June 2001 "in different countries around the world"; that "[f]rom June 1 to January 2002, the Applicant generated \$3.1 Million in the European Union alone"; that the TOF/TOF mark is "not only known to be associated to the product of the Applicant but also known in other parts of the world"; that applicant spends a "considerable amount in advertising and marketing"; and that applicant has used the mark "considerably and spends resources in the US and in other countries as well building its goodwill."

Applicant submitted a USPTO TARR database printout of its registration for the mark MALDI TOF/TOF and a one-page printout that appears to show a search result from an Applied Biosystems corporation website (applicant characterizes this page as a "sample list of marketing and application literature involving the TOF/TOF products"). In its supplemental brief, applicant also states that it "will provide more marketing literature if the Board requests."

Summary Judgment Standard

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving

for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992), and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993), and *Opryland USA*, *supra*.

Acquired Distinctiveness Standard

By seeking registration under Section 2(f), applicant has admitted that its mark is merely descriptive. *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ("Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact").

Applicant ultimately has the burden of establishing that its mark has become distinctive. *Yamaha*, 840 F.2d at

1578. In order to establish acquired distinctiveness, "an applicant must show that 'in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.'" *In re Dial-A-Mattress Operating Corporation*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001), quoting from *Inwood Labs, Inc. v. Ives Labs*, 456 U.S. 844, at footnote 11 (1982).

The issue of acquired distinctiveness is a question of fact. See *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985). There is no specific rule as to the exact amount or type of evidence necessary at a minimum to prove acquired distinctiveness, but generally, the more descriptive the term or phrase, the greater the evidentiary burden to establish acquired distinctiveness. That is, the less distinctive the term or phrase, the greater the quantity and quality of evidence that is needed to prove acquired distinctiveness. See *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and *Yamaha*, 6 USPQ2d at 1008. See also, 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §15:28 (4th ed. 2001).

Trademark Rule 2.41(b) provides that in "appropriate cases, ownership of one or more prior registrations on the Principal Register...of the same mark may be accepted as

prima facie evidence of distinctiveness." [Italics provided]. The rule also states, however, that in such situations, "further evidence may be required."

Decision

After a careful review of the record, we find that opposer has met its burden of establishing the absence of any genuine issues of material fact. Moreover, we find that applicant's proposed mark, TOF/TOF, is highly descriptive of the identified goods and has not acquired distinctiveness.

The evidence of record establishes that the proposed mark, TOF/TOF, is highly descriptive of applicant's goods because it describes a key feature or function, namely that they comprise, utilize or otherwise employ time-of-flight mass spectrometers in tandem. Applicant admits that the identified goods contain time-of-flight mass spectrometers in tandem. (Applicant's responses nos. 7-10 to opposer's requests for admissions.) Opposer has provided the following definitions of the terms "time-of-flight" and "TOF":⁵

Main Entry: **time-of-flight**
Pronunciation: [illegible text]
Function: adjective of, relating to, being, or done with an instrument (as a mass spectrometer) that separates particles (as ions) according to the time required for them to traverse a tube of a certain length <a *time-of-flight* imaging system> <*time-of-flight* magnetic resonance angiography> -- abbreviation TOF

⁵ Merriam-Webster's Online Medical Dictionary, 2005.

Main Entry: **TOF**
Function: abbreviation
time-of-flight

These definitions show that "TOF" is a recognized abbreviation for "time of flight," which is used to describe a feature or type of mass spectrometers.

The exhibits attached to the Zinna declaration include numerous articles, patents and other published documents from industry-oriented publications showing the term "TOF/TOF" as clearly being used to reference tandem, time-of-flight mass spectrometry instruments or analysis. Mr. Zinna avers that he accumulated these materials as a result of Internet and LEXIS/NEXIS database searches. The following is a sampling of excerpts from these materials [emphasis added]:

Tandem time-of-flight (**TOF-TOF**) instruments are indeed few in number, but reflectrons have been used for a number of years to observe and record product ion mass spectra.⁶

Finally, in Chapter 6, Timothy Cornish and I describe a tandem (**TOF-TOF**) instrument using pulsed collision induced dissociation.⁷

A tandem **TOF/TOF** mass spectrometer for studying polyatomic ion/surface collisions has been reported by Cooks et al.⁸

⁶ Page IX (Preface), *ACS Symposium Series, Time-of-Flight Mass Spectrometry*, Robert J. Cotter, Editor. Developed from symposia held at the 204th National Meeting of the American Chemical Society, Washington, D.C., August 23-28, 1992, and the Pittsburgh Conference on Analytical Instrumentation, New Orleans, Louisiana, March 9-12, 1992.

⁷ *Id.* at p. X (Preface).

⁸ *Id.* at p. 12.

This **TOF-TOF** CID spectrum was compared to a linked B/F scan of a magnetic sector instrument...⁹

...as the neutral gas collision source have been successfully demonstrated in this compact **TOF/TOF** design.¹⁰

In this tandem time-of-flight (**TOF/TOF**) system 70, a pulsed primary beam ejects sample ions from a flat target surface.¹¹

Embodiment of tandem mass spectrometry systems, henceforth referred to as **TOF-TOF's**, in accordance with the invention will now be described, by way of example only, with reference to the accompanying...¹²

Many types of mass spectrometers are used with MALDI, including time-of-flight (TOF), Fourier transform (ET), Paul trap, magnetic sector, sector-TOF, TOF-trap, and **TOF-TOF** instruments.¹³

Thus, the system can be viewed as a **TOF-TOF** system with the ability to keep ions outside a desired m/z range from entering the TOF flight tube and effecting detector response.¹⁴

Tandem Time-of-Flight Instruments (**TOF/TOF**) Our initial studies on tandem TOF mass spectrometry were performed using the hybrid magnetic sector/R-TOF instrument.¹⁵

⁹ *Id.* at p. 104.

¹⁰ *Id.*

¹¹ U.S. Patent No. 4,851,669 at p. 7 (filed June 2, 1988, issued July 25, 1989) ["Surface-Induced Dissociation for Mass Spectrometry"].

¹² U.S. Patent No. 5,206,508 at p. 2 (filed October 18, 1991, issued April 27, 1993) ["Tandem Mass Spectrometry Systems Based on Time-of-Flight Analyzer"].

¹³ "MALDI MS and Strategies for Protein Analysis," Fenselau, Catherine. Analytical Chemistry News & Features (November 1, 1997) at p. 3.

¹⁴ "Increasing the Duty Cycle for Time-Of-Flight by Trap-Pulse Mode," Bruce A. Andrien Jr., Erol Gukicek, and Craig Whitehouse. The 47th ASMS Conference on Mass Spectrometry And Allied Topics (June 13-17, 1999, Dallas, Texas).

¹⁵ "Development of Laser-ion Beam Photodissociation Methods" (December 1991-November 1994 Progress Report), D.H. Russel (Dept. Chemistry, Texas A&M University). Prepared June 1994 for the U.S. Department of Energy.

The evidence not only demonstrates the highly descriptive nature of the term "TOF" in the mass spectrometry field but also shows that the syntax commonly used in the industry is to repeat the term (either separated by a hyphen or forward slash) in order to describe a tandem time-of-flight spectrometry instrument or analysis. Applicant's repetition of the term "TOF" is therefore neither novel or arbitrary but only enhances the descriptiveness of the proposed mark.

Because applicant has failed to directly address or rebut any of opposer's evidence, applicant has not raised a genuine issue of material fact in this regard. Indeed, applicant does not even discuss the materials submitted by opposer. Instead, applicant essentially relies on its ownership of a registration, makes several unsubstantiated statements regarding use of its mark, and has submitted a one page website printout in support of its position that its mark has acquired distinctiveness. As discussed below, this meager showing does not raise a genuine issue of material fact.

Applicant states that it "first used the mark TOF/TOF in June 2001 in different countries around the world" and that "from June 1 to January 2002, the Applicant generated \$ 3.1 Million in the European Union alone." Again, these statements, made in its brief, are not supported by any

evidence whatsoever and, even if true, are irrelevant because the issue is whether applicant's mark has acquired distinctiveness *in the United States*. See *In re Men's International Professional Tennis Council*, 1 USPQ2d 1917, 1919-20 (TTAB 1986) and in *In re Bel Paese Sales Co.*, 1 USPQ2d 1233, 1235 (TTAB 1986) [foreign use is essentially of no probative value absent other evidence showing that the foreign use had a material or significant impact on perception of the term by the relevant purchasing public in the United States].

In its supplemental brief, applicant also states that it "spends considerable amount[s] in advertising and marketing" and that it has "used the mark considerably and spends resources in the US and in other countries as well building its goodwill." These broad and vague assertions are also not supported by any documentation.

The single attachment to applicant's supplemental brief is a one page search result printout from a website belonging to Applied Biosystems. The relevant portion of the printout is as follows:

Your requested download links follow:



[The Power of LC MALDI: Identification of Proteins by LC MALDI MS/MS Using the Applied Biosystems 4700 Proteomics Analyzer with TOF/TOF™ Optics: TOF MS: Application Note](#)



[Applied Biosystems 4700 Proteomics Analyzer With TOF/TOF™ Optics Version 2.0 Software: Site Preparation Guide: Rev A2](#)



[Applied Biosystems/MDS SCIEX 4700 Proteomics Analyzer With TOF/TOF™ Optics: Getting Started Guide: Version 3.0 Series Software: Rev A](#)

The term "TOF/TOF" (followed by the "tm" symbol) is used in connection with titles of documents that can be downloaded. However, applicant does not submit any of the actual documents that are linked and it is thus not possible to view whether there is any trademark use by applicant and what, if any, relevance these linked sites have to the proposed mark acquiring distinctiveness.

Applicant also relies heavily on its ownership of Registration No. 2593108 for the mark MALDI TOF/TOF for an "ion source for mass spectrometer." Initially, we note that the goods in the registration are different from those in the subject application and the marks are also different. In any case, ownership of a registration by itself does not raise a genuine issue of material fact as a matter of law - certainly not in this case where applicant's proposed mark is so highly descriptive.

Finally, applicant, in its supplemental brief, stated that it would "submit a copy of a witness statement" or "provide more marketing material" at the Board's request. Applicant does not claim that it needs more time to produce this evidence; rather, it apparently is seeking to hedge its position, i.e., only should the Board be ready to grant opposer's motion would applicant then submit evidence. Such an "offer" is unacceptable and inappropriate. Both parties have been accorded ample time and opportunity to submit any

evidence they may have regarding the issues raised in opposer's motion for summary judgment.

In summary, opposer has demonstrated with overwhelming evidence that "TOF/TOF" is highly descriptive of the identified goods. Given the highly descriptive nature of this term, we would need to see a great deal of evidence in this case in order to find that the term has become distinctive as an indicator of a single source for such goods. See *In re Recorded Books Inc.*, 42 USPQ2d 1275 (TTAB 1997); *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443 (TTAB 1994); *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992); and *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580 (TTAB 1987). And, in this case, applicant has failed to submit any evidence that would raise a genuine issue of material fact bearing on the issue of acquired distinctiveness. We conclude, as a matter of law, that applicant's mark is highly descriptive and that it has not acquired distinctiveness.

In view of the above, opposer's motion for summary judgment is granted. Fed. R. Civ. P. 56. Judgment is hereby entered against applicant, the opposition is sustained, and registration to applicant is refused.

* * *